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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,639	04/21/2004	Wolfgang Becker	H 3624A-PCT/US	5336
23657	7590	10/18/2007		
COGNIS CORPORATION PATENT DEPARTMENT 300 BROOKSIDE AVENUE AMBLER, PA 19002			EXAMINER MCAVOY, ELLEN M	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 10/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/828,639

Applicant(s)

BECKER ET AL.

Examiner

Ellen M. McAvoy

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-13, 15, 16, 18, 19, 21, 22 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-13, 15, 16, 18, 19, 21, 22 and 24-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-13, 15, 16, 18, 19, 21, 22 and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Becker et al (5,439,709) alone or in combination with Aneja (5,837,370).

Applicants' arguments filed 03 August 2007 have been fully considered but they are not persuasive. As previously set forth, Becker et al ["Becker"] disclose lubricating oil compositions for textile fibers for the production of carded yarns which comprise 60-90 % by weight of C<sub>8</sub> to C<sub>22</sub> fatty acid methyl esters, 5-39.95 % by weight of emulsifiers, 0.05 to 10% by weight of homopolymers and/or copolymers of esters of acrylic and/or methacrylic acids, and 0 to 10% by weight of other conventional lubricant additives. Becker teaches that the fatty acid methyl esters are commercially available products which are produced by esterification of the free fatty acid by methods known per se or by transesterification of fatty acid triglycerides with methanol, generally in the presence of acidic catalysts. Suitable natural fatty acid triglycerides include coconut oil, soybean oil, rapeseed oil, sunflower oil, palm oil and tallow. Accordingly, methyl esters of unsaturated and/or saturated C<sub>12</sub>-C<sub>22</sub> fatty acids such as lauric acid, oleic acid, stearic acid, behenic acid, linoleic acid and linolenic acid may be used in the invention of Becker. See column 1, line 51 to column 2, line 2. Thus the examiner maintains the position that the

lubricant compositions of Becker clearly meet the limitations of the claimed lubricant compositions which contain 50-95% by weight of a mixture of C<sub>6</sub> to C<sub>22</sub> fatty acid methyl esters. Although some of the specific fatty acids of the dependent claims are not set forth in Becker such as lauric acid (C<sub>12</sub>), myristic acid (C<sub>14</sub>) and palmitic acid (C<sub>16</sub>), they are examples of saturated and unsaturated fatty acids having 6-22 carbon atoms which may be derived from natural triglycerides. Becker teaches that suitable textile fibers are of natural and/or synthetic origin including wool. See column 4, lines 59-62. Applicants' invention may differ in independent claim 11 by claiming a process for lubricating wool for combed wool sliver production.

However, such a process is set forth in Aneja wherein slivers of wool suitable for processing on a worsted or woollen system are lubricated. See column 1. Thus the examiner is of the position that the claimed invention is clearly taught by Becker alone or in combination with Aneja.

In response, applicants amended claim 11, the only independent claim in the application, to include the proviso "wherein the mixture of fatty acid methyl esters comprises a mixture of methyl esters of coconut fatty acids, palm kernel fatty acids and palm oil fatty acids".

Applicants argue that:

"Nowhere in Becker et. al. is there teaching or suggestion that a mixture of all three of the mixtures of fatty acids of coconut fatty acids, palm kernel fatty acids and palm oil fatty acids be combined and utilized as a lubricant with unexpectedly good lubricating properties. Applicants therefore respectfully submit that a rejection of claims 11-24 over the combination of Becker et al. and Aneja neither teaches nor suggests the present invention."

This is not deemed to be persuasive because, as set forth above, Becker teaches in column 1, lines 51-63, that fatty acid methyl esters are produced from one or more natural triglycerides,

**such as**, coconut oil, soybean oil, rapeseed oil, sunflower oil, palm oil and tallow. The examiner is of the position that term "such as" does not limit the natural triglycerides of the prior art to those listed but broadly includes all such natural triglycerides including palm kernel oil. Further, there is no evidence of record that methyl esters produced from the combination of coconut fatty acids, palm kernel fatty acids and palm oil fatty acids results in a lubricating oil composition with unexpectedly good properties sufficient to rebut the obviousness rejection.

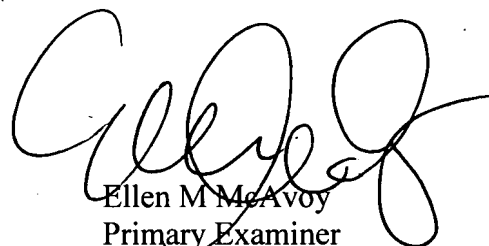
**THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ellen M. McAvoy  
Primary Examiner  
Art Unit 1797

EMcAvoy  
October 9, 2007